

REMARKS/ARGUMENTS

Favorable consideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-4, 6-14, and 16-21 are pending in the application. Claims 5 and 15 are canceled without prejudice or disclaimer and new Claims 20 and 21 are added by the present amendment. As new Claims 20 and 21 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Office Action, the drawings were objected to; Claims 1-19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 1-32 of U.S. Patent Application No. 10/716,535; Claims 1-19 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 14-17, 19-23, 27, 42, 45, and 47-50 of U.S. Patent Application No. 10/062,671; Claims 10 and 16-18 were rejected under 35 U.S.C. §102(e) as anticipated by Clark; Claims 1-4, 6-8, and 11-14 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark et al. (U.S. Patent No. 6,784,869, hereinafter "Clark") in view of Ebert et al. (U.S. Patent No. 5,931,874, hereinafter "Ebert"); Claims 5 and 15 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Ebert and further in view of Yoshino et al. (U.S. Patent No. 5,548,304, hereinafter "Yoshino"); and Claims 9 and 19 were rejected under 35 U.S.C. §103(a) as unpatentable over Clark in view of Ebert and further in view of Oder et al. (U.S. Patent No. 5,475,594, hereinafter "Oder").

With regard to the objection to the drawings, it is respectfully noted that all of the labels listed in the outstanding Office Action are in fact included on Figure 1. A highlighted copy of Figure 1 is included herewith to illustrate this fact. Accordingly, the objection to the drawings is believed to be overcome.

¹See, e.g., the specification at page 11, lines 14-18.

With regard to the provisional non-statutory double patenting rejections of Claims 1-19 in view Claims 1-30 of U.S. Patent Application No. 10/716,535 and Claims 14-17, 19-23, 27, 42, 45, and 47-50 of U.S. Patent Application No. 10/062,671, these rejections are respectfully traversed in light of the terminal disclaimer submitted herewith.

The filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

With regard to the statements in paragraph 6 that the allegedly conflicting claims must be canceled, it is respectfully noted that the claims of the present application ***do not conflict*** with the claims of another application merely because a single element is allegedly included in the claims of two applications. As none of the claims of the present application are identical to any of the claims of U.S. Patent Application No. 10/062,671, and applicant has not (and does not) concede that any of the claims are patentably indistinct, the claims of the present application do not conflict with any of the claims of U.S. Patent Application No. 10/062,671 and thus do not need to be canceled from the present application. See MPEP §822.

With regard to the rejection of Claim 10 as anticipated by Clark, that rejection is respectfully traversed.

Amended Claim 10 recites in part, “providing a priority of movement on the display screen to the main object marker over the auxiliary object marker when the main object marker and the auxiliary object marker are located on a same window.”

The outstanding Office Action conceded with respect to Claims 5 and 15 that neither Clark nor Ebert teaches or suggests any prioritization of the cursors described therein. The outstanding Office Action cited Yoshino as describing a prioritization scheme for multiple cursors. However, Yoshino only describes the determination of priority for selecting the accessing and changing of pages of information, *not priority of control of movement between the cursors*. In fact, Yoshino does not teach or suggest that any of the described cursors has a priority of movement over any other (i.e. all cursors can move independently). Thus, Yoshino does not teach or suggest “providing a priority of movement” as defined in amended Claim 10. Consequently, amended Claim 10 (and Claims 11-14 and 16-20 dependent therefrom) is patentable over Clark and Ebert in view of Yoshino.

With regard to the rejection of Claim 1 as unpatentable over Clark in view of Ebert, that rejection is respectfully traversed.

Claim 1 recites in part:

discretely displacing an auxiliary object marker on the display, responsive object by responsive object, so as to designate a responsive object without affecting control of the main object marker.

The outstanding Office Action cited switches 212a₁, 212a₂, and 212a₃ of Clark as “displacing an auxiliary object marker on the display, responsive object by responsive object.” However, Clark describes a display management system including cursor control device (CCD) 212 that includes a touch screen 212d to move a *single* cursor on a display screen. The switches 212a₁, 212a₂, and 212a₃ move the *same* cursor from one screen to

another screen.² Thus controls 212a₁, 212a₂, and 212a₃ *do not move an auxiliary cursor discretely in the display from one responsive object to another responsive object*. In fact, there is no teaching or suggestion in Clark that the movement of the same cursor from screen to screen by the use of switches 212a₁, 212a₂, and 212a₃ is from one responsive object to another. Thus, Clark does not teach or suggest “discretely displacing an auxiliary object marker on the display, responsive object by responsive object” as recited in Claim 1.

Ebert describes a display 38 that displays cursors 44 and 50. The outstanding Office Action cited the movement of cursor 44 of Ebert as “displacing an auxiliary object marker [44] on the display object [12] without affecting control of the main object marker [50].” However, auxiliary object marker 44 does not designate any responsive objects. Cursor 44 of Ebert is only used to designate a single target for a missile,³ and thus is *not* used to designate *any responsive objects*. Thus, cursor 44 of Ebert is not used in “*discretely* displacing an auxiliary object marker on the display, *responsive object by responsive object*, so as to designate a responsive object without affecting control of the main object marker.” Therefore, Ebert does not teach or suggest “discretely displacing an auxiliary object marker on the display, responsive object by responsive object, so as to designate a responsive object without affecting control of the main object marker” as recited in Claim 1 either.

Further, there is no suggestion or motivation to modify the device of Clark to create the claimed invention. If controls 212a₁, 212a₂, and 212a₃ did move a *second* cursor discretely, responsive object by responsive object, there would be no way to move the *first* cursor from screen to screen. Accordingly, the first cursor would be unsuitable for its intended purpose, which is to be available for use on all the screens of the display management system.⁴ Well settled case law holds that if proposed modification would render

²See Clark, column 5, lines 57-60 and column 6, lines 26-28.

³See Ebert, column 8, lines 27-30.

⁴See Clark, column 6, lines 40-42.

the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See also MPEP §2144.03. Thus, there is no suggestion or motivation to make the proposed modification to Clark.

Accordingly, as neither Clark nor Ebert teach or suggest “discretely displacing an auxiliary object marker” as recited in Claim 1, and there is no suggestion or motivation to modify Clark as proposed, Claim 1 (and Claims 2-4, 6-9, and 21 dependent therefrom) is patentable over Clark in view of Ebert.

With regard to the rejection of Claims 5 and 15 as unpatentable over Clark and Ebert in view of Yoshino, Claims 5 and 15 are canceled, making this rejection moot.

With regard to the rejection of Claims 9 and 19 as unpatentable over Clark and Ebert in view of Oder, it is noted that Claims 9 and 19 are dependent from Claims 1 and 10, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Oder does not cure any of the above-noted deficiencies of Clark and Ebert. Accordingly, it is respectfully submitted that Claims 9 and 19 are patentable over Clark and Ebert in view of Oder.

New Claims 20 and 21 are supported at least by the specification at page 11, lines 14-18. As Claims 20 and 21 are dependent from Claims 1 and 10, Claims 20 and 21 are believed to be patentable for at least the reasons discussed above. In addition, Claims 20 and 21 recited subject matter that further defines over the cited references. As noted above, Clark describes two control devices for moving the *same* cursor. Accordingly, Clark does not describe “a main object marker” and “an auxiliary object marker,” much less “removing the auxiliary object marker from the display screen when the main object marker and the auxiliary object marker designate a same responsive object” as recited in Claims 20 and 21. Further, it is respectfully submitted that none of the other cited references teaches or suggests

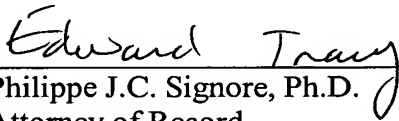
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this feature either. Accordingly, Claims 20 and 21 further patentably define over the cited references.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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